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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,246	05/03/2006	Peter Dopfer	DOPF3003/JEK	8678
23364	7590	05/15/2008	EXAMINER	
BACON & THOMAS, PLLC			SEVERSON, JEREMY R	
625 SLATERS LANE			ART UNIT	PAPER NUMBER
FOURTH FLOOR				3653
ALEXANDRIA, VA 22314			MAIL DATE	DELIVERY MODE
			05/15/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/563,246	Applicant(s) DOPFER ET AL.
	Examiner Jeremy Severson	Art Unit 3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 January 2006.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-24 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 03 January 2006 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-166/08)
Paper No(s)/Mail Date 2/24/06 | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 1 is objected to because of the following informalities:

Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. See 37 CFR 1.75 and MPEP 608.01(i)-(p).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitations "the deposit surface" and "the opposing elements". There is insufficient antecedent basis for these limitations in the claim. For the purpose of expediting prosecution, the claim will be examined as if it depended from claim 8.

Claim 24 is indefinite because it merely recites a use without any active, positive steps delimiting how this use is actually practiced. See Ex parte Erlich, 3 USPQ2d 1011 (Bd. Pat. App. & Inter. 1986). See also MPEP 2173.05(q).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 24 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 24 is a "use claim" that is not a proper process claim under 35 U.S.C. 101. See, e.g., Ex parte Dunki, 153 USPQ 678 (Bd. App. 1967); Clinical Products Ltd. v. Brenner, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966). See also MPEP 2173.05(q).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 and 13-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Filsinger (US 5,538,238).

Re claim 1, Filsinger discloses a singling unit (col. 5, lines 43-44), a first multiaxially movable feeding element 22, a second uniaxially movable feeding element 4.

Re claim 2, in Filsinger the first feeding element 22 brings, by a uniaxial feeding motion, a stack of loose sheet material to be singled from the deposit position to the position in which the uppermost sheet of the stack can be grasped by the singling unit

and, by being drawn out of the feeding path, unites the stack to be singled with a stack to be fed located below the first feeding element.

Re claim 3, in Filsinger the second feeding element 4 brings, by a uniaxial motion on the feeding path, the stack to be fed from the deposit position to a position in which the uppermost sheet of the stack to be fed comes to lie below the first feeding element.

Re claim 4, in Filsinger, the first feeding element 22 assumes the position of the second feeding element 4 by traversing a loop-shaped motion path and being inserted into the feeding path, and the second feeding element returns to the deposit position for receiving a stack to be fed on the feeding path.

Re claim 5, in Filsinger the second feeding element 4 has depressions 21, and the first feeding element 22 is formed complementary so that it can engage the depressions at least partly.

Re claim 6, in Filsinger the first feeding element 22 is moved into the feeding path below the stack of loose sheet material carried by the second feeding element 4.

Re claim 7, in Filsinger the first feeding element 22 has a deposit surface (upper surface of 22) which can be vertically shifted with respect to other components of the first feeding element. If the rods 22 are flipped over, the surface has been vertically shifted with respect to the other parts of the feeding element.

Re claim 8, Filsinger discloses a singling unit (col. 5, lines 43-44), a first multiaxially movable feeding element (comprising elements 22 and 4), and a second multiaxially movable feeding element 9, wherein the first feeding element has a deposit

surface 4 with holes 21, and a plurality of opposing elements 22 which can reach through the holes.

Re claim 9, in Filsinger the deposit surface 4 with holes 21 and the opposing elements 22 can be shifted relative to each other for holding to be able to hold a stack of sheet material to be singled spaced from the deposit surface.

Re claim 10, Filsinger discloses one or more sensors which detect a stack to be fed located in the deposit position. See col. 5, lines 46-60.

Re claims 13-15, Filsinger discloses a method for continuously singling loose sheet material, comprising bringing a stack of loose sheet material to be singled from a deposit position to a position from which an uppermost sheet of the stack is grasped and singled by a singling unit by means of a feeding device having a first multiaxially movable feeding element 22 and a second uniaxially movable feeding element 4, further comprising (a) feeding a stack of loose sheet material to be singled located on the first feeding element to the singling unit, by a feeding motion of the first feeding element on a feeding path, from a deposit position to a position in which the uppermost sheet of the stack can be grasped by the singling unit, singling the fed stack sheet by sheet by the singling unit, the stack being fed by the feeding element such that the particular uppermost sheet of the stack can be grasped by the singling unit, (e) taking over the united stack of loose sheet material by the first feeding element, whereby the first feeding element assumes the position of the second feeding element by traversing a loop-shaped motion path and being inserted into the feeding path, and (f) returning the second feeding element to the deposit position, depositing a further stack of loose

sheet material on the returned second feeding element and then feeding said further stack. See col. 5, lines 40-67.

Re claim 16, in Filsinger the traversing of the loop-shaped motion path of the first feeding element 22 consists of comprises the following steps: (h) perpendicular motion leading away from the feeding path (col. 5, lines 64-65), (i) motion parallel to the feeding path in the direction of the deposit position to a position adjacent the second feeding element (inherent in the reference because such motion is necessary to move rods 22 between steps (h) and (k)), and (k) perpendicular motion leading to the feeding path (col. 5, lines 51-56).

Re claim 17, in Filsinger the first feeding element 22 engages depressions 21 of the second feeding element 4 when being inserted into the feeding path.

Re claim 18, in Filsinger the first feeding element 22 is inserted into the feeding path below the stack of loose sheet material carried by the second feeding element 4.

Re claim 19, Filsinger discloses a method for continuously singling loose sheet material, comprising bringing a stack of loose sheet material to be singled from a deposit position to a position from which an uppermost sheet of the stack is grasped and singled by a singling unit by means of a feeding device having a first multiaxially movable feeding element (comprising elements 9 and 22) and a second uniaxially movable feeding element 4, wherein a deposit surface 22 of the first feeding element is rotated and/or opened and/or horizontally and/or vertically shifted with respect to other components 9 of the first feeding element.

Re claims 20 and 21, in Filsinger a plurality of opposing elements 22 of a first feeding element (comprising elements 9 and 22) reach through holes 21 of a deposit surface 4 of the first feeding element 4 to hold a stack of sheet material to be singled to provide a substantially closed deposit surface.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 11, 12, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Filsinger.

Re claim 11, Filsinger discloses that the first element 22 is driven by a stationary motor 38. Filsinger does not explicitly disclose that the second element 4 is driven by a stationary motor. Filsinger discloses that the second element 4 can be displaced by driving elements. See col. 4, lines 61-67. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a stationary motor as the driving element, in order to provide an inexpensive, durable driving element.

Re claims 12, 22 and 23, Filsinger discloses performing the operations manually. See col. 5, lines 40-67. It would have been obvious to one of ordinary skill in the art at the time of the invention to make the operations automatic, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which

has accomplished the same result involves only routine skill in the art. In re Venner, 120 USPQ 192.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy Severson whose telephone number is (571)272-2209. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey, can be reached on 571-272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeremy Severson/

/Patrick H. Mackey/

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